C4 cont.

wherein said implant is an anhydrous solid structure which is degraded at the site of implantation and releases said therapeutically active non-steroidal antiinflammatory drug within a therapeutic dosage that does not vary by more than about 100% for a period of at least about 3 days.

C5

28. (Amended) An implant according to Claim 25, wherein said release modulator further comprises a second therapeutically active agent.

29. (Amended) An implant according to Claim 28, wherein said second therapeutically active agent is a water soluble antibiotic.

REMARKS

In the Final Office Action mailed April 10, 2001, the Examiner rejected Claims 10, 11, 13, 18 as anticipated by Bernstein *et al.* and Claims 10, 11, 13, 18, 30 and 31 as anticipated by EP 311 065. The Examiner also commented upon the outstanding restriction requirement in the instant application as follows:

> The examiner notes that applicants elected the hydrophilic modulator (other than hydroxy propyl methyl cellulose) and a hydrophobic active in claim 11. Claim 12 remains non-elected, contrary to applicants assertion on the bottom of page 2, paper # 11 ("Response to Office Action mailed June 12, 2000"). See also the "response to the restriction requirement" paper # 7 filed 2/22/00. The examiner further notes that now claimed retardants are disclosed as hydrophobic (page 5, line 18).

[Office Action at p. 3.]. Applicant's attorney spoke with the Examiner on August 28, 2001 by telephone regarding the appropriateness of such a restriction, and it was agreed that Applicant would submit proposed claim amendments along with arguments directed to traversing the restriction requirement and withdrawing the finality of the office action.

The Examiner's original restriction requirement in the instant application imposed a species election between a) an implant comprising any therapeutic agent, b) an implant with a therapeutically active anti inflammatory agent, c) an implant comprising a steroid and d) an implant comprising a non-steroidal anti-inflammatory drug. [Office Action mailed 10/18/99 at p. 2]. With respect to option a), the Examiner further required an election between claims 11, 12, 14 and 15, arguing that

they were generic to a plurality of disclosed patentably distinct species comprising release modulators. [*Id.*]. In response, Applicant elected to proceed with a) an implant comprising any therapeutic agent and the release modulator of Claim 11, *i.e.*, a hydrophilic release modulator. In furtherance of its business interests, without acquiescing to the Examiner's prior art rejections, and expressly reserving the right to pursue similar broad claims in future applications, Applicant now wishes to limit the pending claims to a specific hydrophilic release modulator, hydroxypropyl methylcellulose ("HPMC"), which is the preferred embodiment described and exemplified in the specification. HPMC is currently recited in Claim 12, which depends from Claim 11.

In the most recent Office Action, the Examiner stated for the first time that the original restriction was to a hydrophilic modulator "other than hydroxy propyl methyl cellulose." Applicant respectfully traverses the imposition of such a restriction, since it fails to comply with 35 U.S.C. §121 and 37 C.F.R. §§1.141 & 1.142. 35 U.S.C. §131 provides that the Commissioner may restrict an application when "two or more independent and distinct inventions are claimed in a single application." (Emphasis added.) Similarly, 37 C.F.R. §1.141(a) permits restriction conditioned upon a finding that independent and distinct inventions are found within one application. The Examiner's proposed restriction between HPMC and all other hydrophilic release modulators is improper and contrary to the claim dependency in this case.

M.P.E.P. §802.01 defines independent as follows:

> The term "independent" (*i.e.*, not dependent) means that there is no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation or effect . . . .

The implant recited in Claim 12 is precisely the same as that recited in Claim 11, except that Claim 12 recites a specific and patentably distinct type of hydrophilic release modulator, namely, Applicant's preferred embodiment HPMC. Accordingly, Claim 12 merely recites a narrowing embodiment of the broader implant recited in Claim 11, and a restriction between these claimed inventions is improper since they are not "independent" as required by 35 U.S.C. §131. Applicant respectfully requests that the Examiner reconsider and withdraw the outstanding restriction as between these two claims, and enter Applicant's proposed claim amendments set forth above.

The proposed amended claim amendments are derived from those submitted in Applicant's Preliminary Amendment (paper # 4) and are consistent with amendments made and/or proposed in the parent application, U.S. Ser. No. 08/459,134. Support for the term "anhydrous" may be found

in the teachings of Example 1 on pages 13-15 of the specification. Support for the term "solid structure" may be found on page 8, lines 7-13 and further at page 12, lines 13-28. No new matter has been added. Since Applicant's proposed amendments also fully resolve the Examiner's prior art rejections, Applicant respectfully requests reconsideration and withdrawal of the final rejections in the outstanding office action as premature pursuant to M.P.E.P. § 706.07(c).

Conclusion

Applicant respectfully requests reconsideration of the restriction requirement as set forth above, since the proposed amended claims are proper in that they define a narrower embodiment of the presently-claimed invention which is patentable over the prior art. Entry of the above amendments and allowance at an early date is therefore earnestly requested. Should the Examiner believe that any further obstacles to allowance remain, Applicant encourages the Examiner to contact the undersigned by telephone at (415) 781-1989 or by fax at (415) 398-3249. The Commissioner is hereby authorized to charge any additional fees, including extension fees, to Deposit Account No. 06-1300 (Order No. A-60179-2/DJB/TAL).

Dated: September 17, 2001

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VERSION SHOWING CHANGES MADE

10. An [ocular] implant for controlled, sustained drug release comprising:

a pharmacologically acceptable biodegradable polymer which is degraded at the site of implantation, wherein said biodegradable polymer comprises at least about 20 weight percent of the implant;

a first therapeutically active agent at a concentration from 10 to 50 weight percent of the implant;

a release modulator comprising hydroxypropylmethylcellulose at a concentration from 10 to 50 weight percent of the ~~implant;~~

wherein said implant is an anhydrous solid structure which is degraded at the site of implantation and releases said first therapeutically active agent [is a hydrophilic or hydrophobic entity and said release modulator is the opposite, and said therapeutically active agent is released from said implant] within a therapeutic dosage which does not vary by more than about 100% for a period of at least about 3 days after implantation.

11. Cancelled.

12. Cancelled.

13. An implant according to Claim 10, wherein said anhydrous solid structure is a particle, sheet, patch, plaque, fiber, microcapsule, microsphere or disc.

14. Cancelled.

15. An implant according to Claim 10, wherein said release modulator [is] further comprises a second therapeutically active agent.

16. An implant according to Claim 15, wherein said first therapeutically active agent is a steroid and said [release modulator] second therapeutically active agent is a water soluble antibiotic.

17. An implant according to Claim 15, wherein said first therapeutically active agent is a non-steroidal antiinflammatory drug and said second therapeutically active agent [release modulator] is a water soluble antibiotic.

18. An implant according to Claim 10, wherein said biodegradable polymer is poly-lactate glycolate acid copolymer.

19. An implant for controlled, sustained drug release comprising:

poly-lactate glycolic acid copolymer at a concentration of at least about 20 weight percent of the implant;

a therapeutically active antiinflammatory drug at a concentration from 10 to 50 weight percent of the implant;

a release modulator comprising hydroxypropylmethylcellulose at a concentration from 10 to 50 weight percent of the implant;

wherein said implant is an anhydrous solid structure which releases said therapeutically active antiinflammatory drug within a therapeutic dosage that does not vary by more than about 100% for a period of at least about 3 days.

20. An implant for controlled, sustained drug release comprising:

poly-lactate glycolic acid copolymer at a concentration of at least about 20 weight percent of the implant;

a therapeutically active steroid at a concentration from 10 to 50 weight percent of the implant;

a release modulator comprising hydroxypropylmethylcellulose at a concentration from 10 to 50 weight ~~percent of~~ the implant;

wherein said implant is an anhydrous solid structure which is degraded at the site of implantation and releases said therapeutically active steroid within a therapeutic dosage which does not vary by more than about 100% for a period of at least about 3 days after implantation.

21. Cancelled.

22. An implant according to Claim 20, wherein said anhydrous solid structure is a particle, sheet, patch, plaque, fiber, microcapsule, microsphere or disc.

23. An implant according to Claim 20, where said release modulator [is] further comprises a second therapeutically active agent.

24. An implant according to Claim 23, wherein said [release modulator] second therapeutically active agent is a water soluble antibiotic.

25. An implant for controlled, sustained drug release comprising:

poly-lactate glycolic acid copolymer at a concentration of at least about 20 weight percent of the implant;

a therapeutically active non-steroidal antiinflammatory drug at a concentration from 10 to 50 weight percent of the implant;

a release modulator comprising hydroxypropylmethylcellulose at a concentration from 10 to 50 weight percent of the implant;

wherein said implant is an anhydrous solid structure which releases said therapeutically active non-steroidal antiinflammatory drug [is released] within a therapeutic dosage that does not vary by more than about 100% for a period of at least about 3 days.

26. Cancelled.

27. Cancelled.

28. An implant according to Claim 25, wherein said release modulator [is]further comprises a second therapeutically active agent.

29. An implant according to Claim 28, wherein said [release modulator] second therapeutically active agent is a water soluble antibiotic.

30. Cancelled.

31. Cancelled.

32. Cancelled.

33. Cancelled.